

REMARKS

Claims 1, 2, and 11-16 are pending and at issue.

As an initial matter, the undersigned respectfully requests that the Examiner address all of the arguments made in Applicants' prior response filed on January 25, 2010 so as to reach a clearly defined issue for the final rejection that allows Applicants to determine how best to proceed with the case. Specifically, the undersigned respectfully requests that the following arguments from Applicants' prior response.

Nunn et al has an express object to provide a harness for a child 'that can be quickly applied and removed from the child, and which will not slide or fall from the child,' (column 1, lines 32-33) and achieves this by utilizing its plate (13) to create a bite (19) such that the 'bite 18 is pulled through the bite 19; tightening the harness sufficiently to assure that it will not fall off' (column 2, lines 3-5) because 'the friction between bites 18 and 19 is sufficient to retain the parts in an adjusted position and still permit the parts to be easily adjusted for removal or to assure the child's comfort' (column 2, lines 25-28).

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Furthermore, the proposed modification also is improper because it changes the principle of operation of . . . Nunn et al. Specifically, . . . the principle of operation for Nunn et al is that 'the bite 18 is pulled through the bite 19; tightening the harness sufficiently to assure that it will not fall off' and that 'the friction between bites 18 and 19 is sufficient to retain the parts in adjusted position and still prevent the parts to be easily adjusted for removal or to assure the child's comfort. The proposed modification fundamentally changes both these principles of operation by fixing the arm loops to each other at the stacked location so as to provide "fixed size loops".

As noted in Applicants' prior response, and not at all addressed in the current Office Action with respect to Nunn et al, such a modification "would certainly not allow the adjustment discussed in Nunn et al.", and is:

strictly forbidden under the case law and the standards set forth in the MPEP (see MPEP 2143.01 V, which states that “the proposed modification cannot render the prior art unsatisfactory for its intended purpose” and that “if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, **then there is no suggestion or motivation to make the proposed modification.**”) and (See MPEP §2143.01 VI stating that “the proposed modification cannot change the principle of operation of a reference” and that “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, **then the teachings of the references are not sufficient to render the claims prima facie obvious.** (emphasis added)

It is respectfully requested that the Examiner address these arguments with respect to Nunn et al as modified by Schoenbrun, and specifically, how, despite unambiguous and express prohibitions in the MPEP against such a modification, it is believed permissible to maintain a rejection that prevents the adjustment of the arm loops which is the complete and entire principle of operation of the safety harness in Nunn et al and the express purpose of the safety harness of Nunn et al.

The undersigned also respectfully requests an explanation of exactly what part of the Applicants' arguments the Examiner was referring to with the following:

In response to Applicants' arguments against the references individually, one cannot show nonobvious by attacking references individually where the rejections are based on a combination of references.

Because all of the arguments in Applicants' prior response were directed to the proposed modification, it is not at all clear as to what the Examiner was referring to with the above. In this regard, Applicants' arguments are not in any way similar or analogous to the arguments used by Appellant in the *In re Keller* case cited by the Examiner wherein the Appellants were arguing an affidavit that focused on what a single reference suggested. See *In re Keller*, 642 F.2d 413, 425, 26 (Fed. Cir. 1981)

nor are Applicants' arguments in any way analogous or similar to the arguments of Appellant in the other case cited by the Examiner, *In re Merck & Co., Inc.*, wherein the Applicants were arguing that a single reference taught away from the Appellants' invention (see *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986), stating that the single reference argued by the Appellants (Peterson) must be read not in isolation, but for what is fairly teaches in combination with the prior art as a whole.)

Additionally, it is respectfully requested that the Examiner address Applicants' argument directed towards the modification as applied to Hengstenberger et al, rather than addressing the inaccurate summarization of Applicants' argument provides at page 3 of the Office Action. Specifically, Applicants did not simply argue that "the modification of Hengstenberger et al would be improper as Hengstenberger states that his harness is self-tightening and by pulling the handle 16 the loop 14 would grips the wearer of the jacket ensuring maximum engagement of the victim to pull the victim" as asserted by the Examiner in the rejection. Rather, Applicants quoted Hengstenberger accurately and cited the express language of Hengstenberger as follows:

Specifically, Hengstenberger et al. is specifically directed towards providing "a safety harness which is self tightening and securing upon the wearer." (Column 1, lines 67-68). It achieves this by providing the safety harness having "a continuous loop of material connected to itself at a point to define a first large loop and a second smaller loop" (column 2, lines 13-16), so that "**a pulling force on the handle loop 16 cinches or grips the wearer of the jacket 20 by placing opposing forces across the middle of the back and the front of the shoulders**, assuring that maximum engagement of the victim is achieved by the harness 10" (column 3, lines 40-44). (emphasis added)

It is noted that the Examiner's summary conspicuously leaves out the language bolded above, and particularly the language that is underlined above. Perhaps this is because

the proposed modification clearly prevents the principle of operation shown by that express language. However, this express language from Hengstenberger et al cannot simply be ignored in making a rejection, particularly when it is expressly brought to the Examiner's attention. The undersigned would greatly appreciate the Examiner's position on this language.

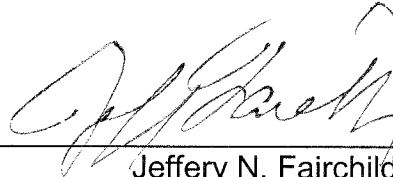
Finally, after reviewing the response in the present Office Action to Applicants' arguments filed January 25, 2010, it is respectfully submitted that the Examiner's assertions that the prior art references are "analogous arts" does absolutely nothing to overcome the express and absolute prohibitions in the MPEP against the type of modifications proposed in the rejections. MPEP §2143.01 VI states that "THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE" and further that "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obviousness." Furthermore, MPEP §2143.01 V states that "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE" and if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The language of these sections of the MPEP is clear and unambiguous and is an express prohibition against the type of modification proposed in the rejection and assertions about "analogous art" are irrelevant to the express prohibition.

In view of the foregoing, Applicants respectfully request that all of Applicants' arguments be addressed in a response so that Applicants may establish a clear issue with the Examiner on Applicants' arguments so as to determine how to move forward in view of the Examiner's final rejection of the claims, that the Examiner address the arguments made, rather than addressing summaries of the arguments made that leave out critical portions of the argument, that the Examiner reconsider the rejections in light of the clear and unambiguous language prohibiting the types of modification proposed in the rejection.

Respectfully submitted,

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